

AUG 07 2006

## FACSIMILE TRANSMISSION

GORDON &amp; REES LLP

ATTORNEYS AT LAW  
2100 ROSS AVENUE, SUITE 2600  
DALLAS, TX 75201  
PHONE: (214) 461-4050  
FAX: (214) 461-4053  
WWW.GORDONREES.COM

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## MESSAGE:

Application No: 09/657,116  
 Applicant : Martinez  
 Title: Spotlight Cursor  
 Examiner: Vu  
 Art Group: 2174  
 Docket No: AUS920000405US1

Attached are the following:

1. Second Amended Appeal Brief; and
2. Transmittal Form

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TRANSMITTAL  
FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 1

Application Number	09/657,118
Filing Date	09/07/2006
First Named Inventor	Martinez
Art Unit	2174
Examiner Name	Vu
Attorney Docket Number	AUS920000405US1

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<small>Remarks</small> Amended Appeal Brief Submitted in Response to Notification of Non-Compliant Appeal Brief mailed 7/12/06		
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Firm Name	Siegesmund & Associates	
Signature	<i>Rudolf O. Siegesmund</i>	
Printed name	Rudolf O. Siegesmund	
Date	August 7, 2006	Reg. No. 37,720

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Typed or printed name	Rudolf O. Siegesmund	Date August 7, 2006

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AUG 07 2006

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/657,116  
Applicant: Martinez  
Filing Date: 9/07/2000  
Group Art Unit: 2174  
Title: Spotlight Cursor

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SECOND AMENDED BRIEF IN SUPPORT OF APPEAL FROM THE PRIMARY  
EXAMINER TO THE BOARD OF PATENT APPEALS & INTERFERENCES**

Dear Sir:

In response to the office communication mailed 7/12/2006, the Applicant submits the following amended brief in compliance with 37 CFR 41.37.

Attorney Docket No. AUS920000405US1  
Serial No. 09/657,116

### **I. Real Party in Interest**

The real party in interest in the present application is International Business Machines Corporation, a New York corporation having a place of business in Armonk, New York.

### **II. Related Appeals & Interferences**

The Applicant has no knowledge of any appeal or interference proceedings that are relevant to the present application.

### **III. Status of Claims**

The Examiner has rejected pending claims 1-20. The Applicant appeals the Examiner's rejection of all pending claims.

### **IV. Status of Amendments**

All of the amendments have been entered in the present case.

### **V. Summary of the Claimed Subject Matter**

#### **A. Independent Claims.**

**1. Claim 1:** The subject matter of claim 1 is a software program for displaying a spotlight cursor having a circumference where the software program directs a computer to display secondary content without user interaction and when the secondary content is covered by a point on the circumference. See Specification, page 2, line 21- page 3, line 4; page 6, line 22- page 7, line 14.

**2. Claim 6:** The subject matter of claim 6 is a computer readable memory for causing a computer having a cursor to display secondary content where a program causes the computer to display a spotlight cursor having a radius, a circumference, and a center located at the forward most point of the cursor so that when the coordinates of the circumference and the secondary

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content coincide, the secondary content is displayed without user interaction. See Specification, page 2, line 21- page 3, line 4; page 6, line 22- page 7, line 14.

**3. Claim 7.** The subject matter of claim 7 is a computer implemented process to accomplish display of secondary content upon activation by a spotlight cursor including, the steps of obtaining the coordinates of the cursor; calculating the location of a circumference; determining whether the circumference has covered a secondary content; causing a secondary content to be displayed without user interaction; and displaying a menu, determining whether or not secondary contents are to be displayed, selecting the radius, selecting intensity, selecting color for area inside the circumference, selecting color of the circumference, selecting configuration of the circumference, and determining the definition of secondary content. See Specification, page 2, line 21 to page 3, line 4; page 6, line 11 to page 7, line 14.

**4. Claim 8.** The subject matter of claim 8 is a method for creating a spotlight cursor for causing secondary content to be revealed by obtaining the coordinates of the cursor, calculating the location of a circumference, determining whether the circumference has covered a secondary content, and causing the secondary content to be displayed without user interaction. See Specification, page 2, lines 21- page 3, line 4; page 6, line 11- page 7, line 14.

**5. Claim 11.** The subject matter of claim 11 is a method for defining a peripheral area around a cursor and displaying a secondary content, associated with an item when the peripheral area intersects the item, without user interaction. See Specification, page 2, lines 21- page 3, line 4; page 6, line 11- page 7, line 14.

**6. Claim 16.** The subject matter of claim 16 is a program product with instructions to define a peripheral area around a cursor, for displaying a secondary content, associated with an

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item when the peripheral area intersects the item, without user interaction. (See Specification, page 2, lines 21- page 3, line 4; page 6, line 11- page 7, line 14.

**B. Dependent Claims.**

**1. Claim 2.** The subject matter of claim 2 is the programmable apparatus of claim 1 and that the circumference is either a solid line, a broken line, or is not visible. See Specification page 5, lines 9-13.

**2. Claim 3.** The subject matter of claim 3 is the programmable apparatus of claim 1 and that the secondary content is either gradual, all or zone. See Specification page 8, lines 22- page 9, line 9; page 9, line 12 – page 10, line 7.

**3. Claim 4.** The subject matter of claim 4 is the programmable apparatus of claim 1 and that the light within the circumference is of selectable and variable intensity. See Specification page 8, lines 2-6.

**4. Claim 5.** The subject matter of claim 5 is the programmable apparatus of claim 1 and that the area inside the circumference is a pre-selectable color. See Specification page 8, line 6-13.

**5. Claim 9.** The subject matter of claim 9 is the method of claim 8 and determining whether the use has selected the spotlight cursor. See Specification page 7, lines 16-19

**6. Claim 10.** The subject matter of claim 10 is the step of determining whether or not the radius has been selected. See Specification page 7, line 19-20.

**7. Claim 12.** The subject matter of claim 12 is the method of claim 11 and that the peripheral area is a circle. See Specification page 5, lines 3-13.

**8. Claim 13.** The subject matter of claim 13 is the method of claim 11 and that the intersection occurs on a graphical user interface. See FIG. 3 and FIG. 4.

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**9. Claim 14.** The subject matter of claim 14 is the method of claim 11 and that the cursor is a pointer. See Specification page 5, lines 4-6.

**10. Claim 15.** The subject matter of claim 15 is the method of claim 11 and that the secondary content is displayed without the cursor intersecting the time. See Specification page 10, line 3-7, FIG. 10.

**11. Claim 17.** The subject matter of claim 17 is the program product of claim 16 where the peripheral area is a circle. See Specification page 5, lines 3-13.

**12. Claim 18.** The subject matter of claim 18 is the program product of claim 16 where the intersection occurs on a graphical user interface. See FIG. 3-4.

**13. Claim 19.** The subject matter of claim 19 is the program product of claim 16 where the cursor is a pointer. See Specification page 5, lines 4-6.

**14. Claim 20.** The subject matter of claim 17 is the program product of claim 16 where the secondary content is displayed without the cursor intersecting the item. See Specification page 10, lines 3-7; FIG. 10.

## VI. Grounds of Rejection

### A. 35 USC §103

The examiner rejected claims 1-20 under 35 USC 103(a) as being unpatentable over Lehikoinen et al ("Lehikoinen", US Pat. No. 6,559,872) in view of Clark et al. ("Clark", U.S. Patent NO. 5,995,101).

**1. Claim 1.** The examiner stated that Lehikoinen discloses "a software program for displaying a spotlight cursor having a circumference, and the computer being directed to display secondary content when said secondary content is covered by a point on the circumference"

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(FIG. 2, 3:15-27; 4:5-20) and that Clark discloses secondary content displayed without user interaction (Fig. 2-3; 1:50-63; 2:51-63).

## **2. Claim 2**

The examiner stated that Lehikoimen discloses a circumference visible as a solid line or a broken line or not visible (FIG. 2; circle 100).

## **3. Claim 3**

The examiner stated that Lehikoimen teaches secondary content that may be "gradual, all or zone" (4:5-20).

## **4. Claim 4**

The examiner stated that Lehikoimen teaches that the circumference is of selectable and variable intensity (4:22-33).

## **5. Claim 5**

The examiner stated that Lehikoimen teaches that the area inside the circumference is a pre-selectable color based upon FIG. 2 and the examiner's statement that "it is inherent that the area inside the circle 100 has a color in order to provide the user a visual indication of the cursor."

## **6. Claim 6**

The examiner stated that Lehikoimen discloses a program to cause "the computer to display a spotlight cursor having a radius, a circumference, and a center located at the forward most point of the cursor wherein responsive to coincidence of coordinates on said circumference and said secondary content, said secondary content is displayed (FIG. 2, 3:15-27; 4:5-20, 3:28-32), and that Clark teaches secondary content displayed without user intervention.

## **7. Claim 7**

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The examiner stated that Lehikoimen discloses the steps of:

- determining whether or not the user has selected the spotlight cursor (4:40-46);
- determining whether or not the radius has been selected (4:22-33 and 50-55);
- obtaining the coordinates of the cursor and calculating the location of the circumference (3:15-25; 3:32-40);
- determining whether the circumference has covered a secondary content and causing the secondary content to be displayed (3:32-40; 4:5-20);
- using a second program, displaying a menu (4:22-33), determining whether or not secondary contents are to be displayed, selecting the radius, and selecting intensity (4:5-20 and 22-33);
- selecting color for area inside the circumference, selecting color of the circumference, and selecting configuration of the circumference (FIG. 2; 4:22-32); and
- determining the definition of secondary content (4:5-20).

The examiner stated that it was inherent that the area inside circle 100 and the perimeter of circle 100 have a color in order to provide a visual indication of the cursor, and that Clark teaches that secondary content is displayed without user interaction (FIGS. 2-3, 1:50-63; 2:51-63).

#### **8. Claim 8**

The examiner stated that Lehikoimen discloses a method obtaining the coordinates of the cursor and calculating the location of a circumference (3:15-25; 3:32-40), determining whether the circumference has covered a secondary content and causing the secondary content to be displayed (3:32-40; 4:5-20), and that Clark teaches the secondary content is displayed without user interaction (FIGS 2-3; 1:50-63; 2:51-63).

#### **9. Claim 9**

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The examiner stated that Lehikoimen discloses determining whether or not the user has selected the spotlight cursor (4: 40-46).

**10. Claim 10**

The examiner stated that Lehikoimen discloses determining whether or not the radius has been selected (4:50-55)

**11. Claim 11**

The examiner rejected Claim 11 for the same reasons as Claim 1.

**12. Claim 12**

The examiner stated that Lehikoimen discloses the peripheral area being a circle (FIG. 2; circle 100)

**13. Claim 13**

The examiner stated that Lehikoimen discloses the intersection occurring on a graphical user interface (FIG. 21, 3:15-20)

**14. Claim 14**

The examiner stated that Lehikoimen discloses the cursor being a pointer (FIG. 3; 4:34-40)

**15. Claim 15**

The examiner stated that Lehikoimen discloses the secondary content being displayed without the cursor intersecting the item (FIG. 3, 4:34-40; 4:5-20; col. 3:28-32), inferring that the cursor is the center of the selection circle.

**16. Claim 16**

The examiner rejected claim 16 for the same reasons that he rejected claim 1.

**17. Claim 17-20**

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The examiner rejected claim 17-20 for the same rationales as claims 12-15.

### **VII. Grounds of Rejection to be Reviewed on Appeal.**

- A. Lehikoinen does not teach or suggest a "cursor having a circumference." (Independent Claims 1, 6, 8)
- B. Lehikoinen does not teach or suggest a circumference that is not visible; a secondary content that is either gradual, all or zone; a circumference that is of selectable and variable intensity, and/or an area inside the circumference that is a pre-selectable color. (Independent Claim 7 and Dependent Claims 2, 3, 4, 5, )
- C. Clark does not teach or suggest a cursor that displays secondary content "without user interaction." (Independent Claims 1, 6, 7, 8, 11 and 16)
- D. Lehikoinen and Clark in combination do not teach or suggest "cursor having a circumference that displays secondary content without user interaction." (Independent Claims 1, 6, 7, 8 and 11)

### **VIII. Argument**

#### **A. Introduction.**

Applicant submits that neither Lehikoinen nor Clark, in combination or alone, teach or suggest the claimed invention as a whole. Specifically, in regard to claims 1-3, 6, 8-10, 11-15, and 16-20, Lehikoinen does not disclose a cursor having a circumference. In regard to claims 4, 5 and 7 there is no evidence that Lehikoinen discloses the additional limitations of those claims. Moreover, even if Lehikoinen and Clark collectively did teach or suggest each individual claim limitation, neither provide any teaching, suggestion, or motivation to modify the prior art to produce the claimed invention as a whole. Thus, the Examiner has not established a *prima facie*

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case of obviousness, and the Applicant respectfully requests the Board to reverse the Examiner's rejections.

### **B. Legal Standard**

The Examiner rejected all claims per 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,559,872 [hereafter Lehikoinen], in view of U.S. Patent No. 5,995,101 [hereafter Clark].

#### Obviousness

In order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure.

*See generally, In re Rouffet, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); In re Fritch, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Fine, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.*

A patent claim is obvious when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; see also *Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. See *Graham*, 383 U.S. at 17-18. When obviousness is based on the teachings of multiple prior art references, the examiner must also establish some "suggestion, teaching, or motivation" that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. See *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). The applicant may rebut a *prima facie* showing of obviousness with evidence refuting the examiner's case or with other objective evidence of nonobviousness. See *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999).

#### Motivation to Combine Prior Art References

"The reason, suggestion, or motivation to combine [prior art references] may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem. " *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed. Cir. 2000) (quoting *Pro-Mold*, 75 F.3d at 1572). "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-

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based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Dembiczak*, 175 F.3d at 999; see also *Ruiz*, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Dembiczak*, 175 F.3d at 999. A person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) ("In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (emphasis added)).

#### Claim Construction

During examination proceedings, claims are to be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). While claims are to be interpreted in light of the specification, limitations from the specification are not to be read into the claims. *Comack Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998). Claim construction analysis begins with the words of the claim. See *Vitronics Corp. v. Conceptronic*,

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*Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves. *Ferguson Beauregard v. Mega Systems*, 350 F.3d 1337, 1338 (Fed. Cir. 2003). "In the absence of an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning . . . . The ordinary meaning must be determined from the standpoint of a person of ordinary skill in the relevant art." *Teleflex v. Ficosa North America*, 299 F.3d 1313, 1325 (Fed. Cir. 2002). The ordinary and customary meaning may be determined by reviewing a variety of sources, including the claims themselves; dictionaries and treatises; and the written description, drawings, and prosecution history. *Ferguson Beauregard*, 350 F.3d at 1338. The ordinary and customary definition will be overcome if the patentee has acted as his or her own lexicographer in explicitly setting forth a definition of a claim term distinct from its ordinary meaning or if "the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002).

### C. Claim Construction.

The term "cursor" should be given its usual and customary meaning. The term "spotlight cursor" should be given the specific meaning stated by the applicant in the specification. The construction of the term "cursor" is important because Lehikoinen uses the term cursor in a manner particular to the Lehikoinen patent, and not in the usual and customary meaning. For example, in the Lehikoinen patent the following statement is made: "[t]he cursor thus comprises the perimeter of the selection circle." (3:35-636). Indeed, Lehikoinen uses the term consistently each of the four times it is used in the patent (the other three times refer to "under the cursor," i.e. the circumference). Applicant's invention, on the other hand, comprises a selection circle

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which is added to an existing cursor so that the selection circle moves as the user moves the cursor (or pointer). The addition of the selection circle to the cursor forms the "spotlight cursor." Applicant uses the term cursor as a distinct component of the "spotlight cursor" invention and does not use the term to refer to the circumference. Specifically, applicant states:

Spotlight cursor 320 has light 314, cursor 311 and "c" 330. Cursor 311 has tip 312. When referring to the coordinates of the cursor, the coordinates are those of the tip 312. The tip is defined as the most forward point of the arrow displayed as the cursor. Persons skilled in the art are aware that any other point on the cursor could be chosen. Tip 312 defines the center of light 314. Light 314 is an area defined by a circle with circumference "c" 330. Light 314 has radius "r" (not shown) which is the straight line distance from tip 312 to "c" 330. (5:3-9)

In order to establish the ordinary and customary meaning of the term "cursor," applicant submits two dictionary definitions. The first is from a 1993 Dictionary of Computing, and the second is from a web based dictionary with a current meaning. As shown below both definitions support a usual and customary meaning of "a pointer that can be moved about a computer display screen by a user."

The *IBM Dictionary of Computing* (George McDaniel, ed., McGraw Hill, Inc. 10<sup>th</sup> Edition 1993, page 159) states the following:

Cursor. (1) A pointer to an element of a set of results. (T) (2) A moveable, visible mark used to indicate a position of interest on a display surface. (A) (3) In SAA Common User Access architecture, a visual cue that shows a user where keyboard input will appear on the screen. See selection cursor, text cursor. (4) In AIX Enhanced X-Windows, the visible shape of the pointer on a screen. A cursor consists of a hotspot, a source bitmap, and a pair of colors. (5) A primitive, such as an arrowhead, that can be moved about the screen by means of an input device, typically a mouse. (6) In SQL, a named control structure used by an application program to point to a row of data. The position of the row is within a table or view, and the cursor is used interactively to select rows from the columns. [emphasis added]

The *IBM Dictionary of Computing* meaning includes "moveable," "visible," "the shape of an arrowhead" and "that can be moved about the screen by means of an input device."

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Webopedia (<http://www.webopedia.com/TERM/c/cursor.html>), a current online dictionary defines cursor as follows:

(1) A special symbol usually a solid rectangle or a blinking underline character, that signifies where the next character will be displayed on the screen. To type in different areas of the screen, you need to move the cursor. You can do this with the arrow keys, or with a mouse if your program supports it. If you are running a graphics-based program, the cursor may appear as a small arrow, called a pointer. (The terms cursor and pointer are often used interchangeably.) In text processing, a cursor sometimes appears as an I-beam pointer, a special type of pointer that always appears between two characters. Note also that programs that support a mouse may use two cursors: a text cursor, which indicates where characters from the keyboard will be entered, and a mouse cursor for selecting items with the mouse. (2) A device, similar in appearance to a mouse, that is used to sketch lines on a digitizing table. Cursors for digitizing tablets are sometimes called pucks. (3) In database languages, short for current set of records, the currently selected set of records. [emphasis added]

The Webopedia definition includes user movement by arrow keys or with a mouse, and in graphics-based programs, a small arrow, called a pointer. Webopedia further states that the terms "cursor" and "pointer" are often used interchangeably.

Therefore, applicant submits that the construction of the term "cursor" as used in applicant's claims is "a pointer that can be moved about a computer display screen by a user." Such a construction is consistent with the specification, and with dictionary definitions reflecting the usage of persons skilled in the art. It would be improper to construe the term "cursor" to include the circumference attached to the cursor because that combination is represented by the separate and distinct term "spotlight cursor." Moreover, the term "spotlight cursor" should be used as defined in the specification which is a cursor with a light (or selection circle) attached.

#### **D. The Prior Art References**

##### Lehikoinen

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Lehikoinen (US Patent 6,559,872) discloses a device for displaying information when the circumference of a circle intersects an object on a display. There are several significant distinguishing features of the Lehikoinen device. First, it is a mobile device with a display connected to a database by a wireless connection to a network (2:40-45). Second, the Lehikoinen device displays a map "of the real world" with selectable objects (2:60-61). Importantly, Lehikoinen does not disclose that the selectable objects are hidden. Rather they are visible so that the user can select them by moving the circumference into contact with one or more of the selectable objects. The selectable objects have coordinates in the real world and the position of the device is determined by a locating service (2:60-3:2). The position of the device in the real world establishes the center of the circle on the map displayed on the device. The user controls only the radius of the circle, and the user can select objects by expanding the radius of the circle to bring the circumference into contact with one or the selectable objects. (3:15-40) Once one of the selectable objects is contacted by the circumference, information may be provided that is textual, graphical, photographic, and/or aural. (4:5-20) The user may activate the selector. Once activated the radius of the circle is set to zero so that the user can then increase (and after increasing, decrease) the radius of the circle (4:41-56). In the preferred embodiment, the center of the selection circle is the location of the device and is centered on the display but may also be located off center (3:28-32).

Significantly, in Lehikoinen, the center of the circle is not moved by the user. While Lehikoinen is silent about exactly how the center of the circle is positioned, it is clear that the user does not do so. The center is established by (perhaps) a locating service. An inference can be drawn that the user may move the center of the circle by moving his or her location, thus

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changing the location of the device in relation to the map on the display. Likewise, the selectable objects would change with the change in the map.

Clark

Clark (US Patent 5,995,101) states in the background section that “tool tips” may be disclosed by placing a cursor over an icon in a toolbar for a “predetermined interval” (1:23). Clark provides a second and third layer of information to the initial “tool tip” using a “trigger interval” or a “selected keystroke.” Clark further states “[r]eferring now to FIG. 4, the process for generating a multi-level tool tip begins when the program detects a cursor entering an area over an icon or control associated with the tool tip (step 100).” (4:20-23). Clark discloses a user placing a cursor directly onto an icon for a predetermined period of time in order to activate secondary content (the tool tip). Clark’s invention is to activate a second or third level of information by holding the cursor for a “trigger interval” or by entering a selected keystroke.

**E. Applicant’s Invention is not Obvious in light of the References**

**1. Lehikoinen does not teach or suggest a “cursor having a circumference”**

The common element in each of the claims upon which the examiner based his rejection, is the “spotlight cursor having a circumference.” Lehikoinen does not disclose a circumference that is attached to a “cursor” if the term ‘cursor’ is given its usual and customary meaning. As discussed above, applicant submits that the construction of the term “cursor” as used in applicant’s claims is “a pointer that can be moved about a computer display screen by a user.” There is no evidence of such a cursor in the Lehikoinen reference.

Claim 1

Claim 1 is as follows:

1. A programmable apparatus for displaying secondary content, comprising:

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a computer;  
a software program for displaying a spotlight cursor having a circumference;  
the computer being directed to display secondary content when said secondary content is covered by a point on said circumference; and  
wherein the secondary content is displayed without user interaction.

In regard to Claim 1, the examiner stated the following (in relevant part):

... a software program for displaying a spotlight cursor having a circumference, and the computer being directed to display secondary content when said secondary content is covered by a point on said circumference (fig. 2; col. 3, lines 15-27; and col. 4, lines 5-20)

Claim 6 is as follows:

6. A computer readable memory for causing a computer having a cursor to display secondary content comprising:

a computer readable storage medium;  
a program stored in said storage medium;  
the storage medium so configured by said program, causes the computer to display a spotlight cursor having a radius, a circumference, and a center located at the forward most point of the cursor; wherein responsive to coincidence of coordinates on said circumference and said secondary content, said secondary content is displayed without user interaction.

In regard to Claim 6, the examiner stated the following (in relevant part):

the storage medium so configured by said program, causes the computer to display a spotlight cursor having a radius, a circumference, and a center located at the forward most point of the cursor wherein responsive to coincidence of coordinates on said circumference and said secondary content, said secondary content is displayed (fig. 2, col. 3, lines 15-27; and col. 4, lines 5-20; col. 3, lines 28-32)

Claim 8 is as follows:

8. A method for creating a spotlight cursor for causing secondary content to be revealed comprising:

obtaining the coordinates of the cursor;  
calculating the location of a circumference;  
determining whether the circumference has covered a secondary content;  
and  
responsive to a determination that the circumference has covered a secondary content, causing a secondary content to be displayed without user interaction..

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In regard to Claim 8, the examiner stated the following (in relevant part):

obtaining the coordinates of the cursor and calculating the location of a circumference (col. 3, lines 15-25; col. 3, lines 32-40)

The sections of the Lehikoinen patent from which the above references were made are the following:

Once the display 10 shows an area with selectable objects 120-125, the user controls the radius of a selection circle 100, which is depicted on the display, to select one of the objects 120-125. As the selection circle changes its radius, the cursor moves away from a previously selectable object toward a next selectable object. The coordinates of the objects may be stored in database 30 in the UE 40. Alternatively, the coordinates may be located in the database 60 in the network 50. In the latter case, once the location of the UE is known, the database 60, which may comprise a much higher capacity than the database 30 of the UE 40, may be searched to determine the coordinates of nearby selectable objects. (3:15-27)

In the preferred embodiment, the center of the selection circle 100 is the location of the user equipment 40 and is centered on the display 10. However, the center of the selection circle 100 may alternatively be located so that it is not centered in the display 10. A user selects an object by adjusting the radius of the selection circle 100 until the radius of the circle equals the distance between the object to be selected and the center of the selection circle 100. The cursor thus comprises the perimeter of the selection circle. In FIG. 2, the object 125 is selected, i.e. "under the cursor". The selected object 125 may be highlighted or otherwise differentiated from the other displayed objects so that the user easily identifies when an object is selected. (3:28-40)

When an object under the perimeter of the selection circle is selected, information about the object is provided visually and/or aurally, to the user. The information may be stored in the UE 40 either by pre-programming or data base 30 through a download from a database, either wirelessly or through a direct connection. Alternatively, the information may be stored in a database 60 of the network 50. Alternatively, or in addition to either of the above alternatives, the UE 40 may be connected to an internet or intranet website where upon information about the object is provided to the UE 40. The information may be textual, graphical, photographic, and/or aural. For example, if the objects are pieces of art in a museum, the information about the selected artwork is provided to the user. If the objects are stores in a city, or a shopping mall, the information may be the street address at the stores and/or advertising information. (4:5-21)

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FIG. 4 is an example of a selector which may be used. Selector 20 comprises a '+' button a '-' button and an activation button when the '=' button is pressed, the radius of the selection circle is increased. When the '-' button is pressed, the radius of the selection circle is decreased. The rate of change in radius may comprise a change in radius per time unit that the '=' button or the '-' button is held down. Alternatively, the rate of change in radius may comprise a change in radius per each depression of the '-' button or the '=' button. Depressing the activation button signals that the user has selected a particular object on the display. (4:22-33)

Although the examiner cited references from the above sections of the Lehikoinen patent, the references do not disclose the limitations of the claims. Specifically, the references do not disclose a "spotlight cursor" because such a cursor comprises both a cursor and a light (selection circle) added to the cursor so that the light moves about the display with the cursor.

**2. Lehikoinen does not teach or suggest a circumference that is not visible; a secondary content that is either gradual, all or zone; a circumference that is of selectable and variable intensity, and/or an area inside the circumference that is a pre-selectable color.**

Claims 4, 5 and 7 contain limitations that, contrary to the examiner's assertions, are not present in the cited references.

#### Claim 7

Claim 7 is as follows:

7. A computer implemented process to accomplish display of secondary content upon activation by a spotlight cursor comprising:

using a first program in the memory of a computer, performing the following steps;

determining whether or not the user has selected the spotlight cursor;  
determining whether or not a radius has been selected;  
obtaining the coordinates of the cursor;

calculating the location of a circumference;

determining whether the circumference has covered a secondary content;  
causing a secondary content to be displayed without user interaction;

using a second program in the memory of a computer, performing the following steps:

displaying a menu;

determining whether or not secondary contents are to be displayed;

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selecting the radius;  
selecting intensity;  
selecting color for area inside the circumference;  
selecting color of the circumference;  
selecting configuration of the circumference; and  
determining the definition of secondary content.

In regard to Claim 7, the examiner stated the following (in relevant part):

obtaining the coordinates of the cursor and calculating the location of a circumference (col. 3, lines 15-25; col. 3, lines 32-40); determining whether the circumference has covered a secondary content and causing the secondary content to be displayed (col. 3, lines 32-40; col. 4, lines 5-20); using a second program in the memory of a computer; performing the following steps; displaying a menu (col. 4, lines 22-33); determining whether or not secondary contents are to be displayed, selecting the radius, and selecting intensity (col. 4, lines 5-20, and lines 22-33); selecting a color for area inside the circumference, selecting color of the circumference, and selecting configuration of the circumference (fig. 2; col 4, lines 22-32); it is inherent that the area inside the circle 100 and the perimeter of the circle 100 have a color in order to provide user a visual indication of the cursor); and determining the definition of secondary content (col. 4, lines 5-20),

#### Claim 4

Claim 4 is as follows:

4. The programmable apparatus of claim 1 wherein the light within the circumference is of selectable and variable intensity.

In regard to Claim 4, the examiner stated the following (in relevant part):

Lehikoinen teaches the programmable apparatus of claim 1 wherein the light within the circumference is of selectable and variable intensity (col. 4, lines 22-33).

There is no evidence to support the examiner's basis for rejection of Claim 4 in the cited portion or any where else in Lehikoinen.

#### Claim 5

Claim 5 is as follows:

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5. The programmable apparatus of claim 1 wherein the area inside the circumference is a pre-selectable color.

In regard to Claim 5, the examiner stated the following (in relevant part):

Lehikoinen teaches the programmable apparatus of claim 1 wherein the area inside the circumference is a pre-selectable color (fig. 2; it is inherent that the area inside the circle 100 has a color in order to provide user a visual indication of the cursor.)

There is no evidence to support the examiner's basis for rejection of Claim 5 in the cited portion or any where else in Lehikoinen. Moreover, the examiner's argument that color is inherent is not correct. A circle does not necessarily have a color. The circle may be clear and have the solid line of the circumference as the only visual indicator (as is the case in Lehikoinen).

**3. Clark does not teach or suggest a cursor that displays secondary content "without user interaction."**

In regard to claims 1, 6, 7, 8, and 11 the examiner made the following references to the Clark patent:

... Clark teaches the secondary content is displayed without user interaction (figs. 2-3; col. 1, lines 50-63; col. 2, lines 51-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Clark in the invention of Lehikoinen [sic] because it provides users a multi-level of information without user interactions when one of the objects 120-125 of fig. 2 is under the perimeter of the selection circle.

The sections of the Lehikoinen patent from which the above references were made are the following:

A subsequent (e.g., a second-level) tool tip is displayed if the user continues to point to the area for a predetermined amount of time ("trigger interval") or presses a selected keystroke.

In certain embodiments, the user may determine the trigger interval. Also, the second-level tool tip may replace the first-level tool tip in the graphical display, and the second-level tool tip may include more or different types of information than the first level tool tip, including text, a video clip, or an audio clip.

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Additional levels of information (e.g., higher level tool tips) may be displayed after a previous level of information is displayed. The tool tip may be removed from the graphical display entirely when the user performs a prescribed action. (1:50-63)

Referring also to FIG. 3, a third level tip 62 in turn replaces the second level tip 60 (FIG. 2) if the user does not move the cursor from the icon 54 or take some other prescribed action within a predetermined amount of time (the "level -3 tool tip trigger interval") after the second-level tip 60 first appeared. The third level tip 62 may include, e.g., an even more detailed textual explanation of the icon's function, a graphical image 64 or a multimedia clip (e.g., an audio/visual clip) demonstrating the icon's function in detail, or a combination of these. The program may include as many additional, higher-level tips as needed to fully demonstrate the program function associated with the icon 54. (2:51-63)

Clark discloses a second and third layer tool tip that is used in conjunction with a first tool tip. The first tool tip is in the prior art for the Clark patent. In Clark, the cursor must be placed directly over an icon for a trigger interval to cause the second or third item of information to be displayed. The tool tips in Clark are revealed because a user has moved a cursor to a visible icon, and then taken some action to cause the information to be displayed. Therefore, Clark does not support rejection of the limitation "without user interaction" because the user must first place the cursor onto a visible icon and then keep the cursor on the icon for a predetermined interval.

**4. Lehikoinen and Clark in combination do not teach or suggest "cursor having a circumference that displays secondary content without user interaction."**

The examiner did not show how a person skilled in the art, confronted with the same problems as the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed. More specifically, the examiner provided no evidence or argument that a person skilled in the art would have combined the prior art teachings in the particular manner claimed. The examiner provided no evidence of a suggestion, teaching, or motivation to combine. Rather the examiner,

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combined the two references with the benefit of hindsight, using the applicant's claims as a guide. Clark contains no suggestion to combine a "tool tip" with a spotlight that can be moved with a cursor to cause hidden information to be revealed.

#### IX. Conclusion

Neither Lehikoinen nor Clark, in combination or alone, teach or suggest the claimed invention as a whole. Specifically, in regard to claims 1-3, 6, 8-10, 11-15, and 16-20, Lehikoinen does not disclose a cursor having a light where the light covers a peripheral area within a circle defined by a circumference. In regard to claims 2, 3, 4, 5 and 7 claims, there is no evidence that Lehikoinen discloses the additional limitations of claims 2, 3, 4, 5 and 7. Moreover, even if Lehikoinen and Clark collectively did teach or suggest each individual claim limitation, neither provide any teaching, suggestion, or motivation to modify the prior art to produce the claimed invention as a whole. Thus, the Examiner has not established a prima facie case of obviousness, and the Applicant respectfully requests the Board to reverse the Examiner's rejections.

Respectfully submitted,

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Rudolf O. Siegesmund  
Registration No. 37,720  
Suite 2000  
4627 N. Central Expressway  
Dallas, Texas 75205-4017  
214-528-2407  
FAX 214-528-2434  
Attorney for Applicant

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## APPENDIX OF CLAIMS

1. A programmable apparatus for displaying secondary content, comprising:
  - a computer;
  - a software program for displaying a spotlight cursor having a circumference;
  - the computer being directed to display secondary content when said secondary content is covered by a point on said circumference; and
  - wherein the secondary content is displayed without user interaction.
2. The programmable apparatus of claim 1 wherein said circumference is visible as a solid line or a broken line or not visible.
3. The programmable apparatus of claim 1 wherein said secondary content is one of the following: gradual, all or zone.
4. The programmable apparatus of claim 1 wherein the light within the circumference is of selectable and variable intensity.
5. The programmable apparatus of claim 1 wherein the area inside the circumference is a pre-selectable color.
6. A computer readable memory for causing a computer having a cursor to display secondary content comprising:
  - a computer readable storage medium;
  - a program stored in said storage medium;
  - the storage medium so configured by said program, causes the computer to display a spotlight cursor having a radius, a circumference, and a center located at the forward most point

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of the cursor; wherein responsive to coincidence of coordinates on said circumference and said secondary content, said secondary content is displayed without user interaction.

7. A computer implemented process to accomplish display of secondary content upon activation by a spotlight cursor comprising:

using a first program in the memory of a computer, performing the following steps;

determining whether or not the user has selected the spotlight cursor;

determining whether or not a radius has been selected;

obtaining the coordinates of the cursor;

calculating the location of a circumference;

determining whether the circumference has covered a secondary content;

causing a secondary content to be displayed without user interaction;

using a second program in the memory of a computer, performing the following steps:

displaying a menu;

determining whether or not secondary contents are to be displayed;

selecting the radius;

selecting intensity;

selecting color for area inside the circumference;

selecting color of the circumference;

selecting configuration of the circumference; and

determining the definition of secondary content.

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8. A method for creating a spotlight cursor for causing secondary content to be revealed comprising:

obtaining the coordinates of the cursor;  
calculating the location of a circumference;  
determining whether the circumference has covered a secondary content; and  
responsive to a determination that the circumference has covered a secondary content,  
causing a secondary content to be displayed without user interaction..

9. The method of claim 8 further comprising the step of determining whether or not the user has selected the spotlight cursor.

10. The method of claim 8 further comprising the step of determining whether or not the radius has been selected.

11. A method comprising:

defining a peripheral area around a cursor;  
displaying a secondary content associated with an item upon a determination that the peripheral area intersects the item; and  
wherein the secondary content is displayed without user interaction.

12. The method of claim 11 wherein the peripheral area is a circle.

13. The method of claim 11 wherein the intersection occurs on a graphical user interface.

14. The method of claim 11 wherein the cursor is a pointer.

15. The method of claim 11 wherein the secondary content is displayed without the cursor intersecting the item.

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**16. A program product comprising:**

**a computer readable medium;**

**wherein the computer usable medium comprises instructions comprising:**

**instructions for defining a peripheral area around a cursor;**

**instructions for displaying a secondary content associated with an item upon a determination that the peripheral area intersects the item; and**

**wherein the secondary content is displayed without user interaction.**

**17. The program product of claim 16 wherein the peripheral area is a circle.**

**18. The program product of claim 16 wherein the intersection occurs on a graphical user interface.**

**19. The program product of claim 16 wherein the cursor is a pointer.**

**20. The program product of claim 16 wherein the secondary content is displayed without the cursor intersecting the item.**

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**EVIDENCE APPENDIX**

**NONE**

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**RELATED PROCEEDINGS APPENDIX**

**NONE**